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| 09/990,032      | 11/21/2001  | Takahiro Kudo        | MTS-3290US          | 2767             |

7590 12/28/2004

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| EXAMINER |
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THAI, HANH B

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| ART UNIT | PAPER NUMBER |
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2161

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/990,032

Applicant(s)

KUDO ET AL.

Examiner

Hanh B Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6, 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/19/02 &amp; 7/28/04</u> . | 6) <input type="checkbox"/> Other: _____  |

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This is in response to application filed November 21, 2001 in which claims 1-20 are presented for examination.

### **DETAILED ACTION**

#### ***Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 7-13, 17-20, drawn to a pattern matching access system, classified in class 707, subclass 6.
- II. Claims 6, 14-16 and 18-20, drawn to a distribution of promotion program, classified in class 705, subclass 14.

Inventions I and II are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (I) as claimed does not require the particular of the subcombination II as claimed because it is a pattern matching access system that need not be connected to a distribution program. The subcombination II has separate utility such as a user promotion for distribution. Therefore, the inventions are distinct; however, they could be usable together.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

### ***Election***

3. A telephone call was made to Daniel Calder (registration number 27424) on November 18, 2004; a provisional election was made with traverse to prosecute the invention of "Group I", claims 1-5, 7-13, 17-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6, 14-16 and 18-20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

Abstract of disclosure: See 37 CFR 1.72(b) and MPEP § 608.01(b). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

The abstract of the disclosure is objected to because it is not written in a single paragraph. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP

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§ 2172.01. The omitted steps are: the preamble of claim 11 recites, “ a group forming”, however, the step in the claim body does not perform the grouping.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the claim recites “a mass”, at line 2, page 73, and is unclear.

Art rejection is applied to claim 13 as best understood in light of rejection under 35 U.S.C. 112, second paragraph discussed above.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-13 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

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In the present case, although claims 7, 9, 10, 11 and 13 all recite a method at the preamble for a group forming, however, the claim body merely requires obtaining, classifying, judging and monitoring information, which can be implemented by the mind of a person or by the use of a pencil and paper. In other words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deemed to be directed to non-statutory subject matter.

Claims 17 and 18 recite at best software alone, not tangibly implemented in any computer readable medium.

Claims 19-20 recite "a medium" which is broad enough to read on a piece of paper. Furthermore, "a medium" can carry a wave or signal, thus is directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7-10, 12-13 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Knight et al. (US 6,571,234).

Regarding claim 1, Knight discloses a group forming system comprising:

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- a terminal apparatus which is connected to a network (Fig.2 and col.8, lines 15-21, Knight);
- accumulating means of obtaining information (col.4, line 66 to col.5, line 5; col.15, lines 15-18 and col.25, lines 1-14, Knight) including at least one of personal information and preference information of a user of said terminal apparatus, and of accumulating the obtained information (col.23, lines 44-57 and col.25, lines 15-26, Knight);
- classifying means of classifying a whole or a part of the information accumulated in said accumulating means, into a single or plural groups on the basis of a predetermined classification criterion (col.4, line 66 to col.5, line 5 and lines 17-24; col.6, lines 14-17; col.7, lines 7-17; col.10, lines 12-15 and col.11, line 66 to col.12, line 47, Knight); and determining and notifying means of determining the group to which the user is to belong, from the classified groups on the basis of predetermined relationships between the user and the accumulated information, and of notifying the user of a result of the determination (col.17, lines 25-40 and col.25, line 66 to col.26, line 6, Knight).

Regarding claim 2, Knight discloses a group forming apparatus comprising:

- accumulating means of obtaining information including at least one of personal information and preference information of a user of a terminal apparatus which is connected to a network, and of accumulating the obtained information (col.4, line 66 to col.5, line 5; col.15, lines 15-18 and col.25, lines 1-14, Knight);

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- classifying means of classifying a whole or a part of the information accumulated in said accumulating means, into a single or plural groups on the basis of a predetermined classification criterion (col.4, line 66 to col.5, line 5 and lines 17-24; col.6, lines 14-17; col.7, lines 7-17; col.10, lines 12-15 and col.11, line 66 to col.12, line 47, Knight); and
- determining and notifying means of determining the group to which the user is to belong, from the classified groups on the basis of predetermined relationships between the user and the accumulated information, and of notifying the user of a result of the determination (col.17, lines 25-40 and col.25, line 1 to col.26, line 6, Knight).

Regarding claim 3, Knight discloses a group forming apparatus according to claim 2, wherein said apparatus further comprises activity judging means of judging a degree of activity of the group on the basis of a history and/or a frequency of postings of information (col.3, lines 25-39 and lines 40-59, Knight) to the group from the user belonging to the group, and from a result of the judgement, it is determined whether a whole or a part of the classification is reorganized or not, in accordance with the degree of activity of the group (col.20, lines 54-65, Knight).

Regarding claim 5, Knight discloses a group forming apparatus according to claim 2, wherein said apparatus further comprises monitoring means of monitoring plural sets of information which are posted to the group from the user belonging to the group, and in accordance with similarity of the plural sets of monitored information, the group is divided, or



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plural groups are integrated with each other (col.21, lines 13-39; col.24, lines 51-67 and col.25, lines 15-26, Knight).

Regarding claim 7, Knight discloses a group forming method comprising:

- an accumulating step of obtaining information including at least one of personal information and preference information of a user of a terminal apparatus, and of accumulating the obtained information (col.4, line 66 to col.5, line 5; col.15, lines 15-18 and col.25, lines 1-14, Knight);
- a classifying step of classifying a whole or a part of the accumulated information into a single or plural groups on the basis of a predetermined classification criterion (col.4, line 66 to col.5, line 5 and lines 17-24; col.6, lines 14-17; col.7, lines 7-17; col.10, lines 12-15 and col.11, line 66 to col.12, line 47, Knight); and
- a determining and notifying step of determining a group to which the user is to belong, from the classified groups on the basis of predetermined relationships between the user and the accumulated information, and of notifying the user of a result of the determination (col.17, lines 25-40 and col.25, line 1 to col.26, line 6, Knight).

Regarding claim 8, Knight discloses a group forming method according to claim 7, wherein, in said accumulating step, also information related to the classified groups is accumulated, and in said classifying step, the classification is performed in consideration of also the accumulated information related to the groups (col.4, line 66 to col.5, line 5; col.15, lines 15-18 and col.25, lines 1-14, Knight).

Regarding claim 9, Knight discloses a group forming method comprising:

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- a storing step of storing personal information or preference information of a user belonging to a group which is formed on Internet (col.4, line 66 to col.5, line 5; col.15, lines 15-18 and col.25, lines 1-14, Knight), with classifying the information into first information which shows a stable tendency for a predetermined time period, and second information which, for the predetermined time period, shows a degree of change in tendency that is larger than a degree of change in tendency of the first information (col.25, lines 15-18 and col.26, lines 14-49, Knight discloses a group forming system that stores the user profile including user's name and address. The user's name and address corresponding to the "first information" and "second information", and the degree of change in tendency of the user's address is larger than the degree of change in tendency of the user's name.)
- a classification result obtaining step of, on the basis of a first classification criterion, classifying a whole or a part of information including the first information in the stored information, into a single or plural groups to obtain a first classification result, and of, on the basis of a second classification criterion, classifying a whole or a part of information including the second information, into a single or plural groups to obtain a second classification result (col.4, line 66 to col.5, line 5 and lines 17-24; col.6, lines 14-17; col.7, lines 7-17; col.10, lines 12-15 and col.11, line 66 to col.12, line 47 and col.14, lines 33-67, Knight); and
- a determining and notifying step of determining the group by using the first classification result, of determining the group by using the second classification

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result, and of notifying the user of results of the determinations (col.17, lines 25-40 and col.25, line 1 to col.26, line 6, Knight).

Regarding claim 10, Knight discloses a group forming method comprising:

- an activity judging step of judging a degree of activity of a group which is formed on Internet, on the basis of a history and/or a frequency of postings of information to the group from a user belonging to the group (col.8, lines 22-40 and col.25, line 1 to col.26, line 6, Knight);
- a determining step of, from a result of the judgement, determining whether a whole or a part of single or plural groups is reorganized or not, in accordance with the degree of activity of the group (col.14, lines 32-66, Knight); and
- a reorganizing step of reorganizing the groups on the basis of a result of the determination (col.8, lines 22-40; col.11, lines 1-30 and col.19, lines 62-66, Knight).

Regarding claim 12, Knight discloses a group forming method according to claim 11, wherein the provision of the provided information on the basis of the predetermined criterion includes the steps of: on the basis of at least one of personal information and preference information of a user belonging to the group, judging whether the user has known the keyword or not; and, if it is judged that the user has not yet known the keyword, providing the provided information (col.25, line 1 to col.26, line 6, Knight).

Regarding claim 13, Knight discloses a group forming method comprising:

- a monitoring step of monitoring plural sets of information posted to a group which is formed on Internet (col.6, lines 25-39 and line 60 to col.7, line 6; col.19, lines 63-66; col.26, lines 59-64 and col.27, lines 63-67, Knight); and

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- a step of, in accordance with similarity of the plural sets of information, automatically dividing a mass, or integrating plural masses together (col.8, lines 22-40; col.9, lines 60-67 and col.10, lines 12-15, Knight).

Regarding claims 17-20, these claims are rejected for the same reasons discussed in claims 2 and 7 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knight et al. (US 6,571,234) in view of Sato et al. (US Pub. 2002/0128907).

Regarding claim 4, Knight discloses a group forming apparatus according to claim 2, wherein said apparatus further comprises: keyword judging means of judging whether or not a preregistered keyword is included in information which is posted to the group from the user belonging to the group (col.17, lines 25-40; col.19, line 62 to col.20, line 34 and col.25, line 66 to col.26, line 6, Knight). Knight, however, does not disclose provided information which is previously stored with being paired with the keyword, ..., on the basis of a predetermined criterion. Sato, on the other hand, discloses an information delivery and advertisement scheme including the keyword pair stored in the database management system ([0107]; [0112] and [0125], Sato). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knight to include the claim feature as taught by Sato. The motivation of

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doing so would provide an efficient system that can deliver information to interested customers ([0024] and [0025], Sato).

Regarding claim 11, Knight discloses a group forming method comprising:

- a judging step of judging whether or not a preregistered keyword is included in information which is posted to a group that is formed on Internet (col.8, lines 22-51 and col.25, line 1 to col.26, line 44, Knight); and
- a providing step of, if a result of the judgement shows that the keyword is included, providing provided information which to the group or a user posting the information to the group, on the basis of a predetermined criterion.

Knight, however, does not disclose provided information which is previously stored with being paired with the keyword, ..., on the basis of a predetermined criterion. Sato, on the other hand, discloses an information delivery and advertisement scheme including the keyword pair stored in the database management system ([0107]; [0112] and [0125], Sato). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Knight to include the claim feature as taught by Sato because of the security reason ([0112] and [0113], Sato).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Krishan et al. (US 6,442,529) disclose methods and apparatus for delivering targeted information and advertising over the Internet.

2. Bondy (US Pub. 2003/0046147) discloses method and system for selling a plurality of items.

3. Niamir (US Pub. 2002/0027567) discloses listing network for classified information.
4. Ben-Natan et al. (US Pub. 2003/0158897) disclose networked platform for creating and supporting communities.
5. Yu (US Pub. 2002/0143759) discloses computer searches with results prioritized using histories restricted by query context and user community.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B Thai whose telephone number is 571-272-4029. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hanh B Thai  
Examiner  
Art Unit 2161

December 15, 2004

  
**UYEN LE**  
**PRIMARY EXAMINER**